

REMARKS

Status of the Claims

Claims 1, 2, 4-7, 10-15, 17-19 and 22-34 were in the application.

Claims 1, 2, 4-7, 10-15, 17-19, and 22-34 stand rejected.

Claims 22-24, 28-30,-33 and 34 are objected to.

By way of this amendment, claims 7, 22 and 23 have been amended and claims 15, 17-19, 24 and 27-32 have been canceled.

Upon entry of this amendment, claims 1, 2, 4-7, 10-14, 22, 23, 25, 26, 33 and 34 will be pending.

Prematurity of the finality of the rejections

The rejection has been indicated to be final. The Office asserts that Applicants amendment necessitated the new grounds of rejection. Applicants respectfully urge that the finality of the rejection is premature, and that the new grounds of rejection were not necessitated by amendment made by Applicants. Applicants request that the finality of the rejection be withdrawn and that Applicants be given the opportunity to further amend the claims in the event the claims are net deemed allowable upon entry of this amendment.

The new rejection under 35 USC 103(a) could have been made previously and was not necessitated by any amendment made by Applicants. Entering this new rejection as final is improper and the finality should be withdrawn as premature. In the event that the claims are not allowable at this time, Applicants respectfully request that the finality be withdrawn and that Applicants be provided an opportunity to provide further amendments.

Summary of the Amendment

Claim 7 has been amended to add structure to the paragraph format thereby more clearly setting forth the scope and contents of the claims. The amendment is in form and style only.

The scope and subject matter of the claims is identical to that of the claims prior to amendment. No new matter is added and no new issues are raised.

Claims 22 and 23 have been amended to delete unnecessary words. The amendment is in form and style only. The scope and subject matter of the claims is identical to that of the claims prior to amendment. No new matter is added and no new issues are raised.

Claims 15, 17-19, 24 and 27-32 have been canceled without prejudice.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Previous Rejection - Maintained

Claims 22-24, 28 and 29 have been rejected under 35 USC 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention.

The Office maintains that as written the claims refer to proteins encoded by proteins. This interpretation is wholly incorrect. One skilled in the art would not interpret the claims as asserted by the Office. Claims 24, 28 and 29 have been canceled and the rejection is moot as applied to those claims. In an effort to advance prosecution and without changing the scope or subject matter of the claims, claims 22 and 23 have been amended to more clearly set forth the subject matter by deleting extraneous verbiage. As amended, the claims are clear and definite and the rejection is moot as applied to those claims as well.

Applicants respectfully request that the rejection of claims 22 and 23 under 35 USC 112, second paragraph, be withdrawn.

Claim Rejections – 35 U.S.C. § 112, First Paragraph

Previous Rejection - Maintained

Claims 15, 17, 18, 19, 24, 29 and 32 have been rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. Applicants respectfully

disagree but in an effort to advance prosecution of the other pending claims, claims 15, 17-19, 24, 29 and 32 have been canceled and the rejection is moot.

Claim Objections

Claims 30-32 have been objected to as being identical in scope to claims 1, 7 and 15 respectively. Claims 30-32 have been canceled and the objections are moot.

Claims 22-24, 28 and 29 have been objected to as having informalities. Claims 24, 28 and 29 have been canceled and the objection as applicant to those claims is moot. Claims 22 and 23 have been amended and the rejection as applied to those claims is also moot.

Claim Rejections – 35 U.S.C. § 112, First Paragraph

New Ground of Objection and Rejection

Claims 7, 10-13, 15, 17-19, 23-26, 28, 29 and 31-34 have been rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

Claims 15, 17-19, 24, 28, 29, 31 and 32 have been canceled and the rejection is moot as applied to those claims.

The Office has interpreted claims 7 to refer to three nucleic acid molecules. Claim 7 has been amended to include paragraph headings which clarify that the composition of claim 7 contains 2, not 3, nucleic acid molecules. The first molecule contains coding sequences an immunogen and a listed immunomodulatory protein and the second nucleic acid molecule encodes Ox40. As amended, the subject matter of the claims is clearly not as interpreted by the Office and is fully supported by the specification.

Applicants respectfully request that the rejection of claims 7, 10-13, 23, 25, 26, 33 and 34 under 35 USC 112, first paragraph, as failing to comply with the written description requirement be withdrawn.

Claim Rejections – 35 U.S.C. § 103

New Ground of Objection and Rejection

Claims 1, 2, 4-6, 22, 27 and 30 have been rejected under 35 USC 103(a) as being unpatentable over Weinberg and Hinuma.

Weinberg teaches using Ox40 ligand and other molecules that bind to Ox40 to induce an enhanced immune response.

Hinuma teaches an HSVgD vaccine.

It is asserted that the combination of references render the claims prima facie obvious. Applicants respectfully disagree.

The rejection apparently arises from a misunderstanding of the content of Weinberg and the nature of the invention. Weinberg teaches using Ox40 ligand and other molecules that bind to Ox40, not Ox40 itself. Weinberg teaches targeting Ox40 with other molecules. The instant invention uses nucleic acid molecules that encode Ox40 as immunostimulatory molecules. Weinberg neither teaches nor suggests using Ox40. In fact, one skilled in the art reading Weinberg would be discouraged from using Ox40. Since Weinberg teaches the desirability to provide molecules that bind to Ox40, one skilled in the art would conclude from Weinberg that providing Ox40 itself would be counterproductive since Ox40 produced from nucleic acids delivered as part of the invention would bind to Ox40 ligand and compete against cells expressing Ox40 which Weinberg teaches should be targeted.

Nothing in Hinuma teaches or suggests Ox40 as an immunostimulatory molecule.

The combination of Weinberg and Hinuma do not render the claimed invention obvious. The combination does not produce the claimed invention and in fact, Weinberg teaches away from the claimed invention.

Applicants respectfully request that the rejection of claims 1, 2, 4-6, 22, 27 and 30 under 35 USC 103(a) as being unpatentable over Weinberg and Hinuma be withdrawn.

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Conclusion

Claims 1, 2, 4-7, 10-14, 22, 23, 25, 26, 33 and 34 are in condition for allowance. A notice of allowance is earnestly solicited. Applicants invite the Examiner to contact the undersigned at 610.640.7855 to clarify any unresolved issues raised by this response. In the event that any rejection is maintained, Applicants respectfully request that the finality of the rejections be withdrawn and that Applicants be given an opportunity to further amend the application.

The Commissioner is hereby authorized to charge any deficiencies of fees and credit of any overpayments to Deposit Account No. 50-0436.

Respectfully submitted,

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